

REMARKS

Applicants have carefully reviewed this Application in light of the Office Action mailed November 1, 2006. Claims 1-48 are pending in this Application and Claims 1-48 stand rejected under 35 U.S.C. § 102(e). Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-48 stand rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2006/0227957 by Robert A. Dolan et al. ("*Dolan*"). Applicants respectfully traverse and submit that the cited references is not prior art under applicable patent law.

Claims 1-48 stand rejected under 35 U.S.C. § 102(e), which reads in relevant part as follows:

A person shall be entitled to a patent unless ... the invention was described in ... (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent... .

35 U.S.C. § 102(e).

If 35 U.S.C. § 102(e) is read without reference to any other statute, it provides that with respect to the presently examined patent application, a published United States patent application is prior art if and only if it is filed prior to the invention date of the claimed invention in the presently examined patent application. In such a case, *Dolan* could not be considered prior art, as its filing date of December 5, 2005 is well after the date of invention of the present application (which is on or before April 9, 2001, the filing date of the present application). However, applicable patent law provides that in certain instances, the filing date of an application for purposes of Section 102(e) may be the date of an earlier application from which the later-filed application claims priority. *See, e.g.* 35 U.S.C. § 120; M.P.E.P. § 706.02(1). For an application that does not claim priority to an international application, its filing date of the purposes of Section 102(e):

is its earliest effective U.S. filing date, taking into consideration ***any proper benefit claims to prior U.S. application*** under 35 U.S.C. 119(e) or 120 ***if the prior application(s) properly support the subject***

matter used to make the rejection in compliance with 35 U.S.C. § 112, first paragraph.

M.P.E.P. § 702.02(1)(I) (emphasis added).

Dolan claims priority to numerous U.S. nonprovisonal applications and U.S. provisional applications, of which U.S. application Serial No. 09/539,375 (filed March 31, 2000), now U.S. Patent No. 6,477,246 (*Dolan* '246) and its associated U.S. Provisional Patent Application No. 60/127,434 (filed April 1, 1999) were filed prior to the filing date of the present application. (Paragraph [0002]). However, the particular subject matter of *Dolan* used to make the rejections of Applicants' Claims is not supported by the disclosures set forth *Dolan* '246, and the Examiner, in rejecting Claims 1-48, relies on subject matter in *Dolan* disclosed subsequent to the invention date of the present application. Applicants submit that if the Examiner were to allege that *Dolan* '246 properly supports the subject matter used to make the Examiner's rejection, the Examiner should cite to those particular sections and figures of *Dolan* '246 that purportedly support the anticipation rejections, rather than rely on subject matter of *Dolan* disclosed after Applicants' date of invention and/or date of filing.

For at least the reasons set forth above, Applicants submit that the portions of *Dolan* relied upon by Examiner in making rejections under 35 U.S.C. § 102(e) are not prior art pursuant to applicable law. Accordingly, the cited reference cannot anticipate Claims 1-48. As such, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102(e) allow Claims 1-48.


CONCLUSION

Applicants appreciate the Examiner's careful review of the application. Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. For the foregoing reasons, Applicants respectfully request reconsideration and full allowance of Claims 1-48.

Applicants believe there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2581.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants


Paula D. Heyman
Reg. No. 48,363

Date: Jan 30, 2007

SEND CORRESPONDENCE TO:

BAKER BOTTS L.L.P.

CUSTOMER ACCOUNT NO. **31625**

512.322.2581

512.322.8383 (fax)